



AF/2833
The

402-038-19

IN THE UNITED STATES PATENT & TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Applicant: David G. McCarthy : Examiner: B. Hammond
Title: Retractable Receptacle : Group Art Unit: 2833
For Furniture :
Serial No. 08/951,276 :
Filed: October 16, 1997 :

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Attn: Mail Stop Appeal Brief - Patents

TRANSMITTAL OF APPEAL BRIEF

The following documents are enclosed herewith for filing:

1. Appeal Brief in triplicate together with Appendix of
Appealed Claims, Related Proceedings Appendix, copy of Petition
to Commissioner, copy of Decision On Petition, copy of Request
for Reconsideration of Petition to Commissioner, and copy of
Decision on Request For Reconsideration; and

I hereby certify that this correspondence is
being deposited with the United States Postal Service
as first class mail in an envelope addressed to
Commissioner for Patents, P.O. Box 1450, Alexandria,
VA 22313-1450, on the date indicated below.

Mark P. Stone 3/1/05
MARK P. STONE (Date of Deposit)
Reg. No. 27,954

2. Credit Card Payment Form for filing fee for Appeal Brief
at small entity rate.

The enclosed Appeal Brief is being filed within two months
of the date of the filing of the Notice of Appeal.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Mark P. Stone', written in a cursive style.

Mark P. Stone
Reg. No. 27,954
Attorney for Applicant
25 Third Street, 4th Floor
Stamford, CT 06905
(203) 329-3355



402-038-19

IN THE UNITED STATES PATENT & TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Applicant: David G. McCarthy : Examiner: B. Hammond
: :
Title: Retractable Receptacle : Group Art Unit: 2833
For Furniture : :
Serial No. 08/951,276 : :
Filed: October 16, 1997 : :

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Attn: Mail Stop Appeal Brief - Patents

APPEAL BRIEF

I. INTRODUCTION -

This is an appeal from the final rejection of Claims 1 - 20 made by the Primary Examiner in the Official Action dated November 18, 2004.

A Notice of Appeal was timely filed in the Patent & Trademark Office.

03/04/2005 EAREGAY1 00000025 08951276

01 FC:2402

250.00 00

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on the date indicated below.

Mark P. Stone
MARK P. STONE
Reg. No. 27,954

3/1/05
(Date of Deposit)

Appealed Claims 1 - 20 are reproduced in the Appendix of
Appealed Claims, attached hereto.

II. REAL PARTY IN INTEREST -

Electri-Cable Assemblies, Inc., a Connecticut corporation
currently maintaining its principal place of business at 10
Mountain View Drive, Shelton, Connecticut 06484, is the real
party in interest.

III. RELATED APPEALS AND INTERFERENCES -

A prior Appeal by Applicant to the Board was made from a
final rejection by the Primary Examiner dated August 31, 1999 for
the present patent application. The August 31, 1999 final
rejection rejected Claims 1 - 20 (in a form identical to the form
of Claims 1 - 20 presented for review in the present Appeal) both
on formal grounds and on prior art grounds. Applicant's Appeal
Brief, arguing both the formal and prior art grounds of
rejection, was filed on January 9, 2000. In an Examiner's Answer
filed on April 11, 2000, the Primary Examiner withdrew all
grounds of prior art rejection raised in the Final Action dated
August 31, 1999, but maintained the formal grounds of rejection
raised in the Final Action dated August 31, 1999.

By Decision dated October 31, 2002, the Board reversed the
formal grounds of rejection made in the Final Action dated August
31, 1999. A copy of the Board's prior decision is enclosed
herewith in the "Related Proceedings Appendix".

Subsequent to the Board's Decision dated October 31, 2002, the application was remanded to the Primary Examiner. However, instead of issuing a Notice of Allowance since no outstanding grounds of rejection remained, the Examiner, in an Official Action dated March 7, 2003, without explanation, re-opened prosecution of the application on the merits, asserting prior art rejections against the claims based upon the same prior art references previously applied by the Examiner in the Final Action dated August 31, 1999 and expressly withdrawn by the Examiner in the Examiner's Answer dated April 11, 2000.

On April 15, 2003, subsequent to the receipt of the Official Action dated March 7, 2003 in which the Examiner re-opened prosecution of the application on the merits, Applicant filed a Petition To Commissioner Under 37 CFR. 1.181. The Petition argued that re-opening of prosecution on the merits after Decision On Appeal for the purpose of rejecting claims based upon the same prior art references applied by the Examiner prior to the Appeal and expressly withdrawn by the Examiner in the Examiner's Answer, violated the provisions of 37 CFR 1.198. By Decision On Petition dated November 19, 2003, the Director of Technology Center 2800 denied Applicant's Petition. On December 11, 2003, Applicant filed a Request For Reconsideration of the denial of the Petition. By Decision On Petition dated October 5, 2004, the Deputy Commissioner For Patent Examination Policy maintained the earlier Decision of the Director of Technology Center 2800. Copies of the original Petition to Commissioner,

the Request For Reconsideration filed by Applicant, and the two (2) Decisions On Petition by the Patent & Trademark Office, are enclosed.

The Primary Examiner, in the Official Action dated November 18, 2004, placed all claims under Final Rejection based upon the same prior art applied in the earlier Official Action dated March 7, 2003 which re-opened prosecution of this application on the merits. Claims 1 - 20 presented for review in the instant Appeal are identical to Claims 1 - 20 which were presented for review in the prior Appeal.

IV. STATUS OF CLAIMS

Claims 1 - 20 are pending in the instant patent application. No claims have been cancelled, and no claims are allowed. The Final Rejection of Claims 1 - 20 made in the Official Action dated November 18, 2004 is presented to the Board for review in the present Appeal.

V. STATUS OF AMENDMENTS -

Applicant filed a Request For Reconsideration After Final Rejection on November 26, 2004. The Request For Reconsideration presented arguments in support of the allowance of the pending claims, but did not seek to revise any of the claims. By Advisory Action dated February 15, 2005 in response to the Request For Reconsideration, the Examiner maintained the

rejection of the claims on the same grounds set forth in the Final Action dated November 18, 2004.

VI. SUMMARY OF CLAIMED SUBJECT MATTER -

The subject matter of the claims presented for review in the instant Appeal is directed to a receptacle for electronic or communications equipment mounted in standard furniture units, such as office conference tables. Referring to Figure 1 of the drawing, the top surface 8 of a table 4 has two square cutout openings 12 for receiving therein a receptacle unit designated by reference numeral 22 (See page 8 of Applicant's specification). The receptacle 22 shown towards the left side of the table top is in a recessed position in which the top surface 24 of the receptacle is coplanar with the top surface 8 of the table. However, the receptacle 22 towards the right side of the table is shown in its extended position in which the top surface 24 of the receptacle is elevated above the top surface 8 of the table, thereby providing access to four sidewalls 26 of the receptacle 22. The sidewalls carry individual receptacles 32 for receiving connecting power cords from electrical and communication equipment on the table top, as for example the computer 14 and the telephone 16. (See Applicant's specification, page 9, first full paragraph through page 10, first paragraph). The receptacle unit 22 is itself connected to external power sources including electrical power lines and communication transmission lines (See Applicant's specification, page 11, lines 1 - 4).

When the receptacle unit 22 is in its extended position as shown to the right on the table top in Figure 1, power lines from equipment on the table top, as for example the telephone 16, are coupled to one of the individual receptacles 32 in one of the walls 26 of the receptacle unit 22. After one or more units of equipment are coupled to the receptacle unit, the receptacle is depressed into its retracted position as shown by the receptacle unit 22 to the left on the table top shown in Figure 1. A gap between the top 24 of the receptacle unit 22 and the periphery of the square shaped opening 12 defined in the table top 8 provides clearance for cords connecting equipment on the table with the receptacle unit 22 so that the receptacle unit can be depressed into its retracted position with one or more cords received in the individual receptacles 32. Releasable locking means maintain the receptacle unit 22 in its retracted position, and resilient means are provided for biasing the receptacle unit 22 into its extended position when the locking means are released (See Applicant's specification, page 10, first paragraph through page 11, first paragraph).

In a further aspect of the claimed invention, a screen or brush on the periphery of the square shaped openings 12, or in the alternative, carried by the periphery of the top surface 24 of the receptacle unit 22, is provided to cover the gap space defined between the top surface 24 of the receptacle 22 and the top surface 8 of the table when the receptacle unit 22 is in its retracted position. In this manner, small articles are prevented

from falling into the gap space when the receptacle unit 22 is in its retracted position (See page 9, last paragraph, lines 14 - 20 of Applicant's specification).

VII. GROUND OF REJECTION TO BE REVIEWED ON APPEAL -

The following issues are presented for review in the present Appeal:

1. Whether Claims 1 - 5 and 7 - 18 are unpatentable under 35 U.S.C. Section 103(a) over Byrne (U.S. Patent No. 4,747,788) in view of Mitchell et al (U.S. Patent No. 4,511,198); and

2. Whether Claims 1 - 2, 4 - 7, 10, 12 - 15 and 19 - 20 are unpatentable under 35 U.S.C. Section 103(a) over Mitchell et al (U.S. Patent No. 4,511,198).

VIII. ARGUMENT -

Before discussing the prior art rejections raised in the Final Action, dated November 18, 2004, Applicant notes that Claims 1, 16 and 19 are the only independent claims pending in the present application and presented for review in the instant Appeal. Independent Claim 1 has been rejected over a combination of the Byrne and Mitchell et al patents, and has been rejected based only upon the Mitchell et al patent; independent Claim 16 has been rejected based only upon a combination of the Byrne and Mitchell et al patents; and independent Claim 19 has been rejected based only upon the Mitchell et al patent. The

following discussion addresses only independent Claims 1, 16 and 19. If these claims are deemed by the Board to be allowable over the prior art references applied in the Final Action, the remaining dependent claims will be allowable at least for the same reasons as their respective parent independent claims.

Each of the pending independent Claims 1, 16, and 19 defines a device in which a top surface of a receptacle is planar with the top surface of an article of furniture in which the receptacle is mounted when the receptacle is in its retracted position. For the reasons to be discussed below, Applicant respectfully submits that none of the prior art applied in the Final Action, either alone or in combination, teaches or suggests the devices defined by independent Claims 1, 16 and 19 when all positively recited features of these claims are considered in the patentability determination, and when the teachings of the prior art references are considered in their entireties, including teachings diverse to Applicant's pending claims.

* * *

With regard to the rejection of independent Claim 1 over a combination of the Byrne and Mitchell patents, the top of the Byrne housing is above the top surface of a work surface in which the housing is mounted when the housing is in a retracted position. See, for example, Fig. 1 of the patent which discloses that a collar 116 mounted to the top of the housing 108 is above both a working surface 104 and the veneer 106 of the working surface, when the housing 108 is in its retracted position. This

arrangement of structure in the Byrne patent is done intentionally. As disclosed at Column 7, Lines 8 - 13, this structural arrangement enables the collar 116 to provide a supporting surface for the housing 108. The patent expressly discloses that "...the outer perimeter of the collar 116 overhangs the slot 102 [the opening in the work surface] so as to be positioned above the work surface 104 with the lower surface of the collar 116 substantially flush with the veneer 106. In this manner, the collar 116 provides a supporting surface for the housing 108." Since the lower surface of the collar 116 is substantially flush with the veneer 106, the upper surface of the collar 116 is clearly elevated above the upper surface of the work surface 104 and the veneer 106.

Modification of the Byrne patent, such that the top surface of the collar 116 is flush with the working surface 104 so that the top surface of the collar 116 is planar with the top of the working surface, would defeat the intended purpose and express objective of the arrangement of structure disclosed by Byrne, namely to enable the bottom surface of the collar 116 to provide a supporting surface for the housing 108 by permitting the outer perimeter of the collar 116 to overhang the slot 102. Clearly, modification of the Byrne patent which would defeat an intended purpose and express objective of that patent is not suggested by the prior art. See, for example, Micro-Chemical, Inc. v. Great Plains Chemical Co., Inc., 41 USPQ 2d 1238 (Fed. Cir. 1997).

The Mitchell patent likewise does not teach or suggest an arrangement by which the top of a housing is planar with the top surface of a working surface when the housing is in a retracted position. On the contrary, the Mitchell patent discloses that the top surface of the housing 50 is recessed below the top of a working surface 12 when the housing is in its retracted position (See Fig. 2 of the drawing). It is therefore necessary to provide a removable closure element (a disk) to be placed over the opening 12 in the work surface to provide an uninterrupted work surface (See Column 3, lines 61 - 68 of the Mitchell specification). Thus, the Mitchell patent provides an uninterrupted top surface by using structure and a structural arrangement (a separate closure disk removably mounted on a recessed annular shoulder 16 in the circular opening 14) which is distinctly different from the structure and structural arrangement disclosed by Applicant and recited in independent Claim 1.

Since neither the Byrne or Mitchell patents teach or suggest the feature of independent Claim 1 in which the top of the housing is planar with the top of the work surface when the housing is in a retracted position, a combination of these references as proposed in the Final Action is clearly not suggested or motivated by the prior art itself. On the contrary, as a result of the diverse teachings of the two references, the only suggestion for modifying/combining the references as proposed in the Final Action must be derived from using Applicant's own disclosure as a guide for the selective

modification/combination. However, a rejection based upon use of Applicant's own disclosure as a guide for combining references is improper as a matter of law. See, for example, In re Fritch, 23 USPQ 2d 1780 (Fed. Cir. 1992); Orthopedic Equipment Co. v. United States, 217 USPQ 193 (Fed. Cir. 1983).

*

*

*

With regard to the rejection of independent Claim 1 as being obvious over the Mitchell patent alone, as discussed above, the top surface of the housing 50 of the Mitchell patent, when in its retracted position, is recessed below a working surface 12 (See Fig. 2 of the drawing), and it is necessary to place a removable cover element over the opening 14 to provide an uninterrupted working surface 12 (See Column 3, lines 61 - 68 of the Mitchell specification). Applicant's independent Claim 1 recites structure and structural arrangement by which the top surface of the housing itself, when in its retracted position, is planar with the top surface of the article of furniture in which the housing is mounted, to provide an uninterrupted top working surface. Thus, the article of furniture defined by independent Claim 1 provides a planar top working surface using structure and structural arrangement which is completely different from that disclosed by the Mitchell patent. Applicant's claimed article of furniture eliminates the need to provide a separate structural elements (a removable cover, an annular shoulder to support the removable cover), for providing an uninterrupted top working surface when the housing is in its retracted position.

There is no suggestion or motivation in the prior art itself to modify the Mitchell patent in any manner rendering independent Claim 1 obvious. Modification of the Mitchell patent to result in the article of furniture recited in independent Claim 1 is not simply making plural parts unitary (as the Patent & Trademark Office contends at page 4 of the Final Action), since the housing 50 and the removable cover serve different functions. Moreover, the Mitchell patent includes a recessed annular shoulder 16 around the opening 14 solely for the purpose of supporting the removable closure element (See Column 3, lines 61 - 68 of the Mitchell specification). Therefore, modification of the Mitchell patent to result in the article of furniture recited in independent Claim 1, would require 1). providing a housing arranged so that the top surface thereof is planar with a working surface when the housing is in its retracted position, 2). elimination of the removable closure element, and 3). further structural modification to eliminate the annular shoulder 16 provided exclusively for the purpose of supporting the removable closure element. Clearly, there is no suggestion or motivation in the prior art itself to modify the structure and structural arrangement of the Mitchell patent in any manner rendering independent Claim 1 obvious. On the contrary, the only suggestion for such modifications must be derived from Applicant's own disclosure, and it is improper to reject independent Claim 1 based upon modifications to the prior art which are taught only by Applicant's disclosure. See, for example, Micro-Chemical, Inc. v. Great Plains Chemical Co., Inc.,

supra; In re Fritch, supra; and Orthopedic Equipment Co.v. United States, supra.

Therefore, although both Applicant's independent Claim 1 and the Mitchell patent provide an uninterrupted working surface when a housing is fully retracted within an opening in the working surface, the structure and structural arrangement disclosed in the Mitchell patent for attaining this objective is distinctly different from the structure and structural arrangement disclosed by Applicant and recited in independent Claim 1.

* * *

With regard to the rejection of independent Claim 16 as being obvious over a combination of the Byrne and Mitchell patents, independent Claim 16 expressly recites that the top surface of the receptacle is planar with the top surface of the article of furniture in which the receptacle is mounted when the receptacle is in its retracted position. Therefore, independent Claim 16 is allowable over a combination of the Byrne and Mitchell patents for the same reasons discussed above with respect to the rejection of independent Claim 1 as being obvious over a combination of the Byrne and Mitchell patents.

* * *

With regard to the rejection of independent Claim 19 as being obvious over the Mitchell patent, independent Claim 19 recites that the top surface of the receptacle is planar with the top surface of an article of furniture in which the receptacle is mounted when the receptacle is in its retracted

position. Therefore, independent Claim 19 is allowable over the Mitchell patent for the same reasons discussed above with respect to the rejection of independent Claim 1 as being obvious over the Mitchell patent.

*

*

*

For the reasons discussed herein and throughout the prosecution of the present patent application, Applicant respectfully submits that neither the Byrne patent, the Mitchell patent, or a combination of the Byrne and Mitchell patents, teaches or suggests the devices defined by independent Claims 1, 16, and 19 when all positively recited features of these claims are considered in the patentability determination. There is clearly no suggestion or motivation in the prior art itself to modify/combine either of these two references in any manner rendering Applicant's independent claims obvious. As a result of the diverse teachings of the applied prior art references, the only basis for modifying/combining these references must be derived from the use of Applicant's own disclosure as a guide. However, it is well established that it is improper, as a matter of law, to use Applicant's own disclosure as a guide for selectively modifying and/or combining different features of prior art references to reconstruct Applicant's claims even if all features of a claim are disclosed individually in different prior art references. Micro-Chemical, Inc. v. Great Plains Chemical Co., Inc., supra; In re Fritch, supra; and Orthopedic Equipment Co. v. United States, supra.

IX. CONCLUSION -

Applicant respectfully submits that independent Claims 1, 16 and 19 are allowable over the prior art applied in the Final Action dated November 18, 2004. The remaining dependent claims are allowable, at least for the same reasons as their respective parent independent claims.

The rejection of Claims 1 - 20 made by the Primary Examiner in the Official Action dated November 18, 2004 should be reversed by the Board.

Respectfully submitted,

A handwritten signature in dark ink, appearing to read 'Mark P. Stone', written in a cursive style.

Mark P. Stone
Reg. No. 27,954
Attorney for Applicant
25 Third Street, 4th Floor
Stamford, CT 06905
(203) 329-3355



402-038-19

IN THE UNITED STATES PATENT & TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Applicant: David G. McCarthy : Examiner: B. Hammond
: :
Title: Retractable Receptacle : Group Art Unit: 2833
For Furniture : :
Serial No. 08/951,276 : :
Filed: October 16, 1997 : :

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Attn: Mail Stop Appeal Brief - Patents

APPENDIX OF APPEALED CLAIMS

Claim 1. In an article of furniture having a top surface and an opening defined in said top surface; the improvement comprising a receptacle unit adapted to be mounted in said opening in said top surface of said article of furniture; said receptacle unit comprising a top and at least one sidewall extending downwardly from said top, said at least one sidewall having at least one receptacle defined therein; and means for selectively displacing said receptacle unit between a retracted position in which said top of said receptacle unit is planar with said top surface of said article of furniture, and an extended position in which said at least one receptacle in said at least one sidewall of said receptacle unit is elevated above the top surface of said article of furniture.

Claim 2. The improvement as claimed in Claim 1 wherein said receptacle unit is oriented and displaceable in a direction which is perpendicular to the top surface of said article of furniture.

Claim 3. The improvement as claimed in Claim 1 wherein said receptacle unit includes a plurality of sidewalls, each of said sidewalls having at least one receptacle therein, each of said sidewalls being recessed inwardly relative to the outer surface of the top of said receptacle unit.

Claim 4. The improvement as claimed in Claim 1 wherein said top of said receptacle unit and said opening in said top surface of said article of furniture are dimensioned such that a gap space is defined between an outer surface of the top of the receptacle unit and the top surface of said article of furniture when said receptacle unit is in its retracted position in said opening in said top surface.

Claim 5. The improvement as claimed in Claim 4 wherein said gap space is of sufficient dimension to permit a transmission line coupled to said receptacle unit to extend through said gap space when said receptacle unit is in its retracted position in said opening.

Claim 6. The improvement as claimed in Claim 1 further including means for resiliently biasing said receptacle unit into said extended position, and cooperating releasable locking means

for opposing said means for resiliently biasing for retaining said receptacle unit in said retracted position.

Claim 7. The improvement as claimed in Claim 4 further including means for at least partially covering said gap space between said receptacle unit and said top surface of said article of furniture to prevent articles from falling into said gap space when said receptacle unit is in said retracted position.

Claim 8. The improvement as claimed in Claim 7 wherein said means for covering includes a brush.

Claim 9. The improvement as claimed in Claim 7 wherein said means for covering includes a screen.

Claim 10. The improvement as claimed in Claim 7 wherein said means for covering is mounted to said top surface of said article of furniture and extends into said opening defined therein.

Claim 11. The improvement as claimed in Claim 7 wherein said means for covering is mounted to said top of said receptacle unit and is carried by said receptacle unit as it is displaced between said extended and retracted positions.

Claim 12. The improvement as claimed in Claim 1 wherein said receptacle unit has a plurality of sidewalls, each of said sidewalls carrying at least one receptacle.

Claim 13. The improvement as claimed in Claim 12 wherein said receptacle unit has a number of said sidewalls corresponding to the number of sides of said article of furniture, said receptacle unit being oriented relative to said sides of said article of furniture, such that a different sidewall of said receptacle unit faces a different side of said article of furniture.

Claim 14. The improvement as claimed in Claim 13 wherein said receptacle unit is generally rectangular shaped.

Claim 15. The improvement as claimed in Claim 13 wherein said receptacle unit is generally squared shaped.

Claim 16. An article of furniture having top surface and an opening defined in said top surface; a receptacle unit mounted in said opening in said top surface; said receptacle unit comprising a top and a plurality of sidewalls extending downwardly from said top; each of said sidewalls being recessed inwardly relative to the top of said receptacle unit; and means for selectively displacing said receptacle unit between a retracted position in which said top of said receptacle unit is planar with said top surface of said article of furniture, and an extended position in

which at least a portion of each of said plurality of sidewalls of said receptacle unit is elevated above the top surface of said article of furniture.

Claim 17. The article of furniture as claimed in Claim 16 wherein said article of furniture has a predetermined number of sides and said plurality of sidewalls of said receptacle unit are equal in number to the number of sides of said article of furniture, and said receptacle unit is oriented relative to said article of furniture such that each of said plurality of sidewalls of said receptacle unit faces a different one of said sides of said article of furniture.

Claim 18. The article of furniture as claimed in Claim 16 wherein said receptacle unit defines a periphery therearound, and said receptacle unit and said top surface of said article of furniture are oriented such that a gap is defined between the periphery of said receptacle unit and said top surface of said article of furniture when said receptacle unit is in said retracted position received in said opening in said top surface of said article of furniture.

Claim 19. An article of furniture having a top surface and an opening defined in said top surface; a receptacle unit mounted in said opening in said top surface; said receptacle unit comprising a top and at least one sidewall extending downwardly from said top, said at least one sidewall having at least one

receptacle defined therein; means for selectively displacing said receptacle unit between a retracted position in which said top of said receptacle unit is planar with said top surface of said article of furniture, and an extended position in which said at least one receptacle in said at least one sidewall of said receptacle unit is elevated above the top surface of said article of furniture; and a housing mounted to an underside of said top surface of said article of furniture, said housing having an open top and being aligned with said opening defined in said top surface of said article of furniture so as to receive said receptacle unit in said housing when said receptacle unit is in said retracted position.

Claim 20. The article of furniture as claimed in Claim 19 wherein said housing includes means for coupling said receptacle unit to an external power source.

RELATED PROCEEDINGS APPENDIX



The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 16

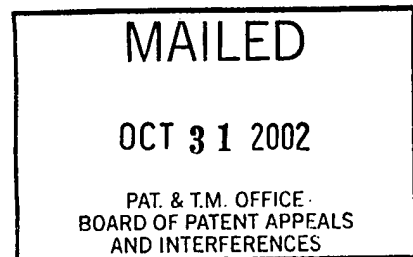
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DAVID G. MCCARTHY

Appeal No. 2001-0076
Application 08/951,276¹

ON BRIEF



Before BARRETT, GROSS, and LEVY, Administrative Patent Judges.
BARRETT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the final rejection of claims 1-20.

We reverse.

¹ Application for patent filed October 16, 1997, entitled "Retractable Receptacle for Furniture."

Appeal No. 2001-0076
Application 08/951,276

BACKGROUND

The invention relates to a retractable receptacle for electronic or communications equipment mounted in a furniture unit, such as office conference tables.

No prior art is relied on in the rejection.

Claims 1-20 stand rejected under 35 U.S.C. § 112, first paragraph, based on a lack of written description. The statement of the final rejection is as follows (Paper No. 8, p. 3):

Claims 1-20 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. There is a lack of written description for the following; "means for coupling said housing", *means for resiliently biasing*; "means" for selectively displacing the receptacle unit; the "open top" of the housing; means for biasing the receptacle unit, locking means. And it is also unclear how the covering means are mounted to the top of the receptacle unit and carried by the receptacle unit as it is being displaced.

The rejections under 35 U.S.C. §§ 102 and 103 have been withdrawn.

We refer to the final rejection (Paper No. 8) (pages referred to as "FR__") and the examiner's answer (Paper No. 13) (pages referred to as "EA__") for a statement of the examiner's position, and to the reply brief (Paper No. 14) (pages referred to as "RBr__") for a statement of appellant's arguments thereagainst.

OPINION

The examiner states in the examiner's answer that the rejection is based on a lack of written description under 35 U.S.C. § 112, first paragraph, not on a lack of enablement (EA3). For this reason, appellant's arguments in the appeal brief (Paper No. 12) to enablement are moot and we refer to the written description arguments in the reply brief (Paper No. 14). However, we note that appellant was correct in interpreting the examiner's rejection as based on lack of enablement instead of lack of written description. The statement of the rejection, that the claims contain "subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention" (FR3), is clearly directed to lack of enablement, as evidenced by the words "enable" and "make and/or use the invention." The reference to "written description" after the statement of the rejection can be interpreted to refer to an insufficient written description to enable the person of ordinary skill in the art to make and use the invention and does not recast the statement of the rejection into one based on a lack of written description. If the examiner had been more careful in stating the rejection, appellant could have responded to the rejection in the brief and would not have

Appeal No. 2001-0076
Application 08/951,276

been put to the time and expense of writing a reply brief and, perhaps, this appeal would have been avoided altogether.

The written description rejection under 35 U.S.C. § 112, first paragraph, is used to reject when a claim is amended to recite elements thought to be without support in the original disclosure. In re Rasmussen, 650 F.2d 1212, 1214-15, 211 USPQ 323, 326 (CCPA 1981). "Satisfaction of the description requirement insures that subject matter presented in the form of a claim subsequent to the filing date of the application was sufficiently disclosed at the time of filing so that the prima facie date of invention can fairly be held to be the filing date of the application." Vas-Cath, Inc. v. Mahurkar, 935 F.2d 1555, 1562, 19 USPQ2d 1111, 1115 (Fed. Cir. 1991), citing In re Smith, 481 F.2d 910, 914, 178 USPQ 620, 623 (CCPA 1973).

It would have been helpful if the examiner's statement of the rejection had pointed to the claims in which the limitations which are said to be without written description support are contained. We agree with appellant's discussion (RBr3) that the "means for coupling said housing" in the rejection must be intended to refer to "said housing includes means for coupling said receptacle unit to an external power source" in claim 20. The "means for resiliently biasing" and "means for biasing the receptacle unit" in the rejection must both refer to the "means for resiliently biasing said receptacle unit" in claim 6. The

"'means' for selectively displacing the receptacle unit" in the rejection must refer to the "means for selectively displacing said receptacle unit" in claims 1, 16, and 19. The "'open top' of the housing" in the rejection must refer to "a housing . . . , said housing having an open top" in claim 19. The "locking means" in the rejection must refer to the "cooperating releasable locking means" in claim 6.

Appellant shows exactly where the disputed limitations are supported in the specification (RBr3-4). We completely agree with appellant. Moreover, there is absolutely no basis for a lack of written description rejection since each of these limitations was in the originally filed claims. We are not prescient and do not know whether the examiner had some other, unexplained, rationale for rejecting the claims.² Thus, the

² We might guess that the examiner bases the rejection on a lack of written description of structure supporting the "means" limitations, except that not all of the noted limitations are in "means" format. To the extent this is the examiner's unexpressed rationale, we note that 35 U.S.C. § 112, sixth paragraph, recites that mean-plus-function language "shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof" (emphasis added). "The emphasized language does not add any additional description requirement to that set forth in the first paragraph of the section." In re Knowlton, 481 F.2d 1357, 1366, 178 USPQ 486, 492-93 (CCPA 1973); In re Comstock, 481 F.2d 905, 908, 178 USPQ 616, 618 (CCPA 1973) (As indicated in Knowlton, "the third [now sixth] paragraph of § 112 does not impose a separate requirement that an invention claimed in 'means-plus-function' form must be described apart from the description requirement expressed in the first paragraph of that section."). The Federal Circuit's decision in In re Dossel, 115 F.3d 942, 42 USPQ2d 1881 (Fed. Cir. 1997) does not address these cases.

Appeal No. 2001-0076
Application 08/951,276

rejection of claims 1-20 based on lack of written description for these limitations is reversed.

The rejection further states (FR3): "it is also unclear how the covering means are mounted to the top of the receptacle unit and carried by the receptacle unit as it is being displaced." This does not appear to be a written description rejection because it questions "how" something is done and we do not find where "covering means" are claimed. This statement is not addressed by appellant. Nevertheless, the rejection is without merit. To the extent the examiner is referring to "said receptacle unit having a top," as recited, for example, in claim 1, this was part of originally filed claim 1 and cannot lack written description. The rejection of claims 1-20 based on lack of written description for this reason is reversed.

Appeal No. 2001-0076
Application 08/951,276


CONCLUSION

The rejection of claims 1-20 is reversed.

REVERSED


LEE E. BARRETT
Administrative Patent Judge

Anita Pellman Gross
ANITA PELLMAN GROSS
Administrative Patent Judge


STUART S. LEVY
Administrative Patent Judge

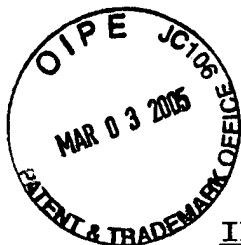
BOARD OF PATENT
APPEALS
AND
INTERFERENCES

Appeal No. 2001-0076
Application 08/951,276

MARK P. STONE
1100 HIGH RIDGE ROAD
STAMFORD, CT 06905



COPIES OF PROCEEDINGS ON PETITION



402-038-19

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

Applicant: David G. McCarthy

Serial No. 08/951,276

Filed: October 16, 1997

Title: Retractable Receptacle
For Furniture

Commissioner for Patents
Washington, D.C. 20231

Attn: Box DAC
Office of Petitions

PETITION TO COMMISSIONER UNDER 37 CFR 1.181

I). INTRODUCTION

The above identified Applicant, by and through his undersigned attorney, hereby petitions the Commissioner under 37 CFR 1.181 to invoke his supervisory authority and vacate the decision in the Official Action dated March 7, 2003 by the Primary Examiner, the Supervisory Patent Examiner, and the Director of Technology Center 2800, re-opening prosecution of this application on the merits under 37 CFR 1.198 after decision by the Board of Patent Appeals & Interferences.

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to Commissioner of Patents & Trademarks, Washington, D.C. 20231, on April 10, 2005
(Date of Deposit)

Mark P. Stone
MARK P. STONE

Reg. No. 27,954

As more fully discussed herein, the re-opening of prosecution on the merits fails to comply with the express requirements set forth in 37 CFR 1.198.

II). STATEMENT OF FACTS

1). In a final action dated August 31, 1999, the Primary Examiner rejected Claims 1, 2, 6 and 16 under 35 U.S.C. Section 102(b) over the Byrne patent (U.S. Patent No. 4,747,788); rejected Claims 19 and 20 under 35 U.S.C. Section 102(b) over the Mitchell et al patent (U.S. Patent No. 4,511,198); and rejected Claims 3 - 5, 7 - 15 and 17 - 18 under 35 U.S.C. Section 103(a) over the Byrne patent (U.S. Patent No. 4,747,788). No claims were allowed.

2). On November 1, 1999, Applicant filed a Request For Reconsideration After Final Rejection;

3). In an Advisory Action dated November 16, 1999, the Examiner maintained the prior art rejection of the claims;

4). On December 2, 1999, Applicant filed a Notice of Appeal. Applicant's Appeal Brief which, inter alia, presented arguments rebutting the prior art rejections in the final action, was filed on January 19, 2000;

5). In the Examiner's Answer dated April 11, 2000, all prior art rejections were withdrawn. Paragraph 6 of the Examiner's Answer expressly states: "The appellant's statement of the issues in the brief is correct; the rejections under 35 USC 102 and 103 are withdrawn.";

6). On October 31, 2002, the Board of Patent Appeals And Interferences reversed all outstanding grounds of rejection under 35 U.S.C. 112 raised against appealed Claims 1 - 20; and

7). In an Official Action dated March 7, 2003, the Examiner re-opened prosecution on the merits and rejected all of the appealed Claims 1 - 20 over the same two prior art references (U.S. Patent Nos. 4,747,788 and 4,511,198) which were applied in the final rejection dated August 31, 1999, and which were expressly withdrawn from the appeal in the Examiner's Answer dated April 11, 2000.

III). ARGUMENT -

37 CFR 1.198 states:

"Cases which have been decided by the Board of Patent Appeals and Interferences will not be reopened or reconsidered by the primary examiner except under the provisions of Section 1.114 or Section 1.196 without the written authority of the Commissioner, and then only for the consideration of matters not already adjudicated, sufficient cause being shown".

Applicant submits, based upon the facts set forth above, that the Examiner lacked authority under 37 CFR 1.198 to re-open prosecution on the merits after appeal and to apply the same prior art references expressly withdrawn by the Examiner in the Examiner's Answer prior to the decision on appeal.

37 CFR 1.198 imposes two requirements on cases re-opened after decision by the Board, namely, 1). that the case can be re-opened only for the consideration of matters not already adjudicated, and 2). that sufficient cause for re-opening prosecution be shown.

In the instant case, the Examiner has re-opened the prosecution for consideration of matters which have already been adjudicated by the Board. The express withdrawal of all prior art rejections in the Examiner's Answer based upon the two prior art patents applied in the final rejection, after Applicant had argued against these prior art rejections in his Appeal Brief, constitutes an adjudication of these rejections in Applicant's favor by default. Although the March 7, 2003 Official Action applies the same two prior art patents in a different manner than they were applied in the final rejection, the current rejections are nonetheless based on the identical prior art patents withdrawn by the Examiner during appeal. The Examiner had the authority to re-open prosecution to withdraw the prior art rejections in the final action based on the arguments advanced in Applicant's Appeal Brief and enter a new ground of rejection

applying the two prior art patents in a different manner prior to the Board's decision on appeal (Manual of Patent Examining Procedure, 8th Edition, August 2001, Section 1208.02), but elected not to do so.

The withdrawal in the Examiner's Answer of the prior art rejections based on the two prior art patents applied in the final action in response to the arguments advanced in Applicant's Appeal Brief, and the failure by the Examiner to enter any new grounds of rejection based on these two patents prior to the decision on appeal, results in an adjudication in Applicant's favor, by default, that the appealed Claims 1 - 20 define patentable subject matter over these two prior art patents. The Official Action dated March 7, 2003, rejecting the same appealed claims over the same two prior art patents withdrawn in the Examiner's Answer, is therefore directed to matters already adjudicated by the decision on appeal, and prosecution on the merits cannot be re-opened under 37 CFR 1.198 to address these matters.

*

*

*

The Official Action dated March 7, 2003 fails to show sufficient cause for re-opening prosecution on the merits, as expressly required by 37 CFR 1.198. In fact, the Official Action does not even address the issue of sufficient cause, nor acknowledge that the rejections being made are based upon the two


identical prior art patents applied in the final action and thereafter expressly withdrawn in the Examiner's Answer during the appeal. The Examiner was clearly aware of the existence of the two prior art references applied in the March 7, 2003 Official Action before the decision of the Board on appeal and, as discussed above, could have re-opened prosecution on the merits to apply these two prior art patents in the manner applied in the March 7, 2003 Official Action prior to the Board's decision. Yet, the Official Action fails to make any showing or provide any explanation as to why the two prior art patents applied in the March 7, 2003 Official Action were not, or could not have been, applied by the Examiner to make the rejections first made in the March 7, 2003 Official Action before the decision by the Board on the appeal. Therefore, the Examiner has failed to make a sufficient showing for re-opening of prosecution on the merits after decision on appeal, as required by 37 CFR 1.198.

IV). CONCLUSION -

Applicant submits that the Official Action dated March 7, 2003, re-opening the prosecution after decision by the Board on appeal, fails to comply with the requirements of 37 CFR 1.198,

and requests that the Examiner be directed to withdraw the prior art rejections of the claims made in the Official Action dated March 7, 2003.

Respectfully submitted,

A handwritten signature in cursive script, appearing to read "Mark P. Stone".

Mark P. Stone
Reg. No. 27,954
Attorney for Applicant
1100 High Ridge Road
Stamford, CT 06905
(203) 329-3355



UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

Paper No. 21

MARK P. STONE
1100 High Ridge Road
Stamford, CT 06905

NOV 19 2003

In re Application of: :
David G. McCarthy :
Serial No.: 08/951,276 :
Filed: October 16, 1997 :
Attorney Docket No.: 402-038-19 :

DECISION ON PETITION

This is a decision on the petition under 37 C.F.R. § 1.181, filed on April 15, 2003.

The petition is DENIED.

The petitioner requests that the decision in the Official Action dated March 7, 2003 be vacated.

A review of the record indicates that the Board of Patent Appeals and Interferences (BPAI) only adjudicated the matter of the rejection under 35 USC §112, 1st paragraph. The BPAI never adjudicated the rejection of the claims over prior art.

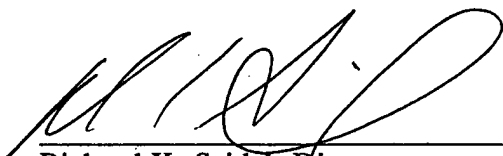
While the art rejection was withdrawn prior to the decision by the BPAI, no where in the record is it indicated that the claims were allowable over the prior art of record.

The Examiner has reopened prosecution and properly rejected the claims on new grounds, albeit using the same prior art, as pointed out by the petitioner. 37 CFR 1.198 states "Cases which have been decided by the Board of Patent Appeals and Interferences will not be reopened or reconsidered by the primary examiner except under the provisions of 37 CFR 1.114 or 1.196 without the written authority of the Commissioner, and then only for the consideration of matters not already adjudicated, sufficient cause being shown." It is our contention that the new grounds of rejection under 35 USC §103 show sufficient cause to warrant the reopening of prosecution.

Accordingly, the petition is denied.

Inquiries regarding this decision should be directed to Paula Bradley at (703) 308-2319.

The case will be forwarded to Examiner Hammond.

A handwritten signature in black ink, appearing to read 'R. K. Seidel', is written over a horizontal line.

Richard K. Seidel, Director
Technology Center 2800
Semiconductors, Electrical and
Optical Systems, and Components

402-038-19

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

Applicant: David G. McCarthy : Examiner B. Hammond
Serial No. 08/951,276 : Group Art Unit: 2833
Filed: October 16, 1997 :
Title: Retractable Receptacle :
For Furniture :

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

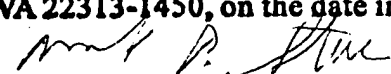
Attn: Box DAC
Office of Petitions

REQUEST FOR RECONSIDERATION OF DECISION
ON PETITION BY TECHNOLOGY CENTER DIRECTOR

The above identified Applicant, by and through his undersigned attorney, hereby requests review of the Decision On Petition dated November 19, 2003 (copy enclosed), by the Director of Technology Center 2800.

On April 15, 2003, a Petition to Commissioner Under 35 CFR 1.181 (copy enclosed) was filed requesting that the decision in the Official Action dated March 7, 2003, to re-open prosecution on the merits after appeal, be vacated. As more fully discussed

**I hereby certify that this correspondence is
being deposited with the United States Postal Service
as first class mail in an envelope addressed to
Commissioner for Patents, P.O. Box 1450, Alexandria,
VA 22313-1450, on the date indicated below.**


MARK P. STONE
Reg. No. 27,954

12/9/03
(Date of Deposit)

in the Petition filed on April 15, 2003, Applicant filed a Notice of Appeal in response to a final rejection by the Primary Examiner dated August 31, 1999, raising both prior art and formal grounds of rejection. Applicant's Appeal Brief addressed both the prior art and the formal grounds of rejection, and the Examiner's Answer expressly withdrew the prior art grounds of rejection. The Board of Patent Appeals And Interferences reversed the formal grounds of rejection but the Examiner re-opened prosecution on the merits raising prior art rejections based upon the same prior art references applied in the final rejection dated August 31, 1999.

In the Petition filed on April 15, 2003, Applicant argued that the re-opening of the prosecution on the merits after appeal to reject the appealed claims on prior art known to and applied by the Examiner prior to the Appeal, where all prior art rejections made prior to the filing of the appeal were expressly withdrawn by the Examiner, violates 37 CFR 1.198 because 1). the grounds of prior art rejection raised by the Primary Examiner in the reopened prosecution have already been adjudicated by the Board (by default), and 2). because the Primary Examiner has failed to show good cause why prosecution should now be reopened to reject claims over identical prior art known to the Examiner prior to the filing of the appeal and expressly withdrawn by the Examiner prior to decision by the Board, as are more fully addressed at Section III, starting at page 3 of Applicant's Petition filed on April 15, 2003.

The Decision on Petition dated November 19, 2003, states that the Board only adjudicated the formal grounds of rejection, and never adjudicated the rejection of the claims over the prior art. However, this occurred only because the Examiner expressly withdrew the prior art rejections in the Examiner's Answer prior to the decision on appeal, but allowed the appeal to proceed based only on the formal grounds of rejection.

The Decision On Petition states "...no where in the record is it indicated that the claims were allowable over the prior art of record." Applicant respectfully disagrees. The fact that the Examiner withdrew all prior art rejections in the Examiner's Answer (in response to the arguments advanced by Applicant in the Appeal Brief that the claims are allowable over the prior art applied in the final action), and that the Examiner allowed the appeal to proceed based only on the formal grounds of rejection is, at the least, an implicit admission that the Examiner considered the appealed claims to be allowable over the prior art of record.

The Decision On Petition dated November 19, 2003, also states that "...the new grounds of rejection under 35 U.S.C. Section 103 show sufficient cause to warrant the reopening of prosecution". However, the Decision On Petition fails to provide any explanation why the new grounds of rejection, which are based upon the identical prior art references cited and applied in the Final Action dated August 31, 1999, were not made by the Examiner

prior to Decision by the Board on Appeal, particularly when the Examiner expressly withdrew all prior art rejections in the Final Action but allowed the Appeal to proceed based only on the formal grounds of rejection.

Applicant respectfully submits, for the reasons addressed in the Petition filed on April 15, 2003, that the reopening of prosecution on the merits after decision by the Board for the purpose of raising prior art rejections based on the identical prior art references applied by the Examiner prior to the Appeal, which were expressly withdrawn by the Examiner prior to the decision by the Board, violates 37 CFR 1.198.

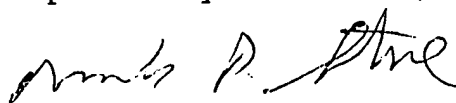
Applicant respectfully requests reconsideration and reversal of the Decision On Petition, dated November 19, 2003, denying Applicant's Petition filed on April 15, 2003.

Enclosed are copies of Petition filed on April 15, 2003, and the Decision On Petition dated November 19, 2003.

Also enclosed is a notice of Change Of Attorney's Correspondence Address. Please forward all further

correspondence regarding this patent application to the address indicated on the enclosed notice.

Respectfully submitted,

A handwritten signature in dark ink, appearing to read "Mark P. Stone". The signature is fluid and cursive, with the first name "Mark" and last name "Stone" being clearly legible, and "P." in the middle.

Mark P. Stone
Reg. No. 27,954
Attorney for Applicant
25 Third Street, 4th Floor
Stamford, CT 06905
(203) 329-3355



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

MARK P STONE
25 Third Street
4th floor
Stamford CT 06905

COPY MAILED

OCT 05 2004

OFFICE OF PETITIONS

In re Application of: :
David G. McCarthy :
Application No.: 08/951,276 :
Filed: October 16, 1997 :
For: RETRACTABLE RECEPTACLE FOR :
FURNITURE :

DECISION ON
PETITION

This is a decision on the petition under 37 CFR 1.181(a)(3) filed on December 11, 2003, invoking the supervisory authority of the Director to review the decision of the Group Director of Technology Center 2800 (Group Director), which decision refused to vacate the reopening of prosecution subsequent to the decision of the Board of Patent Appeals and Interferences.

The petition under 37 CFR 1.181(a)(3) to vacate the reopening of prosecution subsequent to the decision of the Board of Patent Appeals and Interferences is **DENIED**.

BACKGROUND

The final rejection of August 31, 1999, included: (1) a rejection of claims 1 through 20 under 35 U.S.C. § 112, first paragraph as containing subject matter not described in the specification; (2) a rejection of claims 1, 2, 6, and 16, as anticipated under 35 U.S.C. § 102(b) by U.S. Patent No. 4,747,788; (3) a rejection of claims 19 and 20 as anticipated by U.S. Patent No. 4,511,198; and (4) a rejection of claims 3 through 5, 7 through 16, and 17, 18 under 35 U.S.C. § 103(a) over U.S. 4,747,788.

On December 2, 1999, applicant filed a notice of appeal, followed on January 19, 2000 by applicant's brief on appeal. On April 11, 2000, the examiner's answer was mailed. The examiner's answer expressly withdrew the grounds of rejection under 35 U.S.C. §§ 102, 103, but maintained the rejection under 35 U.S.C. § 112, first paragraph.

On October 31, 2002, the Board of Patent Appeals and Interferences issued a decision that noted (at 2) that the rejections under 35 U.S.C. §§ 102, 103 had been withdrawn by the examiner, and reversed the rejection of claims 1 through 20 under 35 U.S.C. § 112 first paragraph.

On March 7, 2003, an Office action was mailed which reopened prosecution by re-applying the prior art references that had been previously employed in the final rejection and then withdrawn in the examiner's answer. The Office action (at 7) was signed, *inter alia*, by the Group Director.

On April 15, 2003 applicant filed a petition seeking that the reopening of prosecution by the Office action of March 7, 2003, be vacated on the grounds that such lacked compliance with 37 CFR 1.198. On December 11, 2003, the Group Director denied the petition on the grounds that the contested reopening was authorized under the terms of 37 CFR 1.198.

The instant petition was filed December 11, 2003.

REGULATION AND EXAMINING PROCEDURE¹

37 CFR 1.198 provides that:

Cases which have been decided by the Board of Patent Appeals and Interferences will not be reopened or reconsidered by the primary examiner except under the provisions of § 1.114 or 1.196 without the written authority of the Commissioner, and then only for the consideration of matters not already adjudicated, sufficient cause being shown.

MPEP 1214.04 states in pertinent part:

If the examiner has specific knowledge of the existence of a particular reference or references which indicate nonpatentability of any of the appealed claims as to which the examiner was reversed, he or she should submit the matter to the Technology Center (TC) Director for authorization to reopen prosecution under 37 CFR 1.198 for the purpose of entering the new rejection. See MPEP § 1002.02(c) and MPEP § 1214.07. The TC Director's approval is placed on the action reopening prosecution.

¹ Manual of Patent Examining Procedure ("MPEP") (8th ed 2001) (Rev. 2, May 2004)

DECISION

Petitioner contends that as the examiner had withdrawn all rejections of the claims over the same prior art references, coupled with the fact that the examiner permitted the appeal to be decided only on the formal grounds *i.e.*, the rejection based on 35 U.S.C. § 112, first paragraph, "is at the least, an implicit admission" by the examiner that the claims are considered allowable over that prior art. Petitioner further complains that the decision fails to provide any explanation why the current grounds of rejection were not made by the examiner prior to the decision by the Board of Patent Appeals and Interferences (BPAI). Petitioner further contends that the re-application of the previously applied, and withdrawn, references, "violates 37 CFR 1.198."

While it is unfortunate that the examiner did not present the current rejections over the same prior art references, such that the BPAI could have all issues before it when the decision of October 31, 2002 was rendered, the reopening of prosecution herein is neither improper under nor inconsistent with 37 CFR 1.198.

The record shows that the prior art-based rejections in the final Office action of August 31, 1999 were not carried forward into the examiner's answer of April 11, 2000. Therefore, the BPAI treated the prior art-based rejections as withdrawn and not before the BPAI for review. See Ex parte Emm, 118 USPQ 180, 181 (Bd. Pat. App. 1957).² The instant situation is akin to the situation in In re Freeman, 166 F.2d 178, 76 USPQ 585 (CCPA 1948), in which: (1) the examiner rejected claims in the application on the basis of (*inter alia*) double patenting; (2) the double patenting rejection was withdrawn by the examiner before the application was forward to the Board of Appeals for a decision on the remaining rejections; (3) the Board of Appeals sustained the rejection of some claims but reversed the rejection of other claims; and (4) the examiner obtained approval to reopen prosecution for the purpose of rejecting claims in the application on the basis of (*inter alia*) double patenting. In response to arguments similar to those being made by petitioner, the CCPA indicated that the fact that the examiner withdrew the double patenting rejection prior to the initial appeal does not preclude the examiner from reopening prosecution (upon obtaining the appropriate approval) and rejecting the claims on the basis of double patenting. See Freeman, 166 F.2d at 179-80, 76 USPQ at 586. Therefore, that the examiner withdrew the prior art-based rejections in the final Office action of August 31, 1999 does not preclude the examiner from obtaining approval to reopen prosecution under 37 CFR 1.198 for the purpose of entering the previously withdrawn prior art based rejections of the claims.

The authority to permit the reopening of prosecution subsequent to a decision by the BPAI under 37 CFR 1.198 has been delegated to the Group Director. See MPEP 1002.02(c), ¶ 1. The Office action that reopened prosecution was signed by the Group Director, thus indicating that the

² Inasmuch as the prior art-based rejections were not before the BPAI for review, these rejections have not already been adjudicated by the BPAI, by "default" or otherwise.

Group Director approved the examiner's request to reopen prosecution in the above-identified application. It is well established that if there is any substantial, reasonable ground within the knowledge or cognizance of the Director why the application should not issue, the Director has the duty, much less the authority, to refuse to issue the application. See In re Drawbaugh, 9 App. D.C. 219, 240 (D.C. Cir 1896). The questions of patentability set forth in the Office action of March 7, 2003 are "sufficient cause" for reopening prosecution in the above-identified application under 37 CFR 1.198.

CONCLUSION

The instant petition is granted to the extent that the decision of the Group Director has been reviewed, but is **denied** as to making any change therein. As the reopening of prosecution in the above-identified application was consistent with 37 CFR 1.198, the Group Director's refusal to vacate the reopening of prosecution subsequent to the decision of the Board of Patent Appeals and Interferences will **not** be disturbed.

Telephone inquiries concerning this decision may be directed to Petitions Examiner Brian Hearn at (571) 272-3217.



Stephen G. Kunin
Deputy Commissioner
for Patent Examination Policy